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Nixon & Vanderhye PC
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714

EXAMINER

NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,200

Applicant(s)

THOMPSON ET AL.

Examiner

Qamrun Nahar

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is in response to the amendment filed on 05/02/2005.
2. Claims 1, 6, 10 and 15 have been amended.
3. Claims 23-29 have been added.
4. Claims 1-29 are pending.
5. Claim 23 stand finally objected to because of informalities.
6. Claims 1-29 stand finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claims 1-29 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gryphon (U.S. 6,233,537) in view of Ernst (U.S. 5,890,133).

Response to Amendment

Claim Objections

8. Claim 23 is objected to because of the following informalities: "An apparatus according to claim 21" should be "A method according to claim 21". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 recite the limitation "the runtime" in line 17 and line 16 of the claims, respectively. There is insufficient antecedent basis for this limitation in the claims. Therefore, this limitation is interpreted as "runtime".

Claims 2-9 and 11-29 are rejected for dependency upon rejected base claims 1 and 10 above, respectively.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gryphon (U.S. 6,233,537) in view of Ernst (U.S. 5,890,133).

Per Claim 1 (Amended):

Gryphon teaches a method of generating a process plan ("A modeling system for the visual presentation of event-driven business processes, composed of multiple plan elements, is provided." in column 1, lines 50-65) comprising: storing at least one generic process plan, storing at least one non-generic process element containing a predetermined pattern ("Visual

BML is modular. Each Visual BML diagram, referred to as a “plan,” describes the attributes and relationships of a single planned process. Each symbol can be deployed (reused) within the plans for other symbols as appropriate.” in column 2, lines 1-5), searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan, and outputting the generated process plan, wherein an instruction coded into each of the at least one non-generic process element determines how content is merged from the non-generic process element into the generic process plan (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57; “Action” is interpreted as a non-generic process element, where “Action” is associated with “Step”. A generic process plan is defined as a sequence of Steps, where each step is searched for an action that is associated with the step, and then an action is defined and deployed as part of the step; thereby, generating a new process plan. The instructions are coded into the Action.). Gryphon does not explicitly teach to generate a process plan at runtime. Ernst teaches to generate a process plan at runtime (column 7, lines 9-23).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Gryphon to generate a process plan at runtime using the teaching of Ernst. The modification would be obvious because one of ordinary skill in the art would be motivated to take into consideration the dynamic behavior of the flow of business process (Ernst, column 2, lines 33-36).

Per Claim 2:

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The rejection of claim 1 is incorporated, and Gryphon further teaches the steps of receiving for storage at least one generic process plan and receiving for storage at least one non-generic process element (column 8, lines 16-25).

Per Claim 3:

The rejection of claim 1 is incorporated, and Gryphon further teaches each stored generic process plan is indexed in accordance with a goal to be achieved by the plan, receiving a goal input, and selecting a generic process plan for searching, said selection being in accordance with the received goal input (column 6, lines 1-14).

Per Claim 4:

The rejection of claim 1 is incorporated, and Gryphon further teaches at least one non-generic process element comprises resource information, identifying one or more resources to support a process step in a generated process plan (column 6, lines 56-66).

Per Claim 5:

The rejection of claim 4 is incorporated, and Gryphon further teaches each stored non-generic process element comprising resource information is indexed in accordance with one or more relevant resources (column 6, lines 56-66).

Per Claim 6 (Amended):

The rejection of claim 1 is incorporated, and Gryphon further teaches wherein content inserted from the at least one non-generic process element comprises data (column 6, lines 56-66).

Per Claim 7:

The rejection of claim 1 is incorporated, and Gryphon further teaches at least one non-generic process element comprises context specific method steps or data and is indexed for storage according to the relevant context (column 6, lines 56-66).

Per Claim 8:

The rejection of claim 7 is incorporated, and Gryphon further teaches the context for at least one non-generic process element is service type (column 6, lines 46-66).

Per Claim 9:

The rejection of claim 7 is incorporated, and Gryphon further teaches the context for at least one non-generic process element is customer type (column 6, lines 56-66).

Per Claim 21:

The rejection of claim 1 is incorporated, and Gryphon further teaches wherein the content introduces new process steps with respect to the generic process plan (column 7, lines 37-40 and lines 52-57).

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Per Claim 22:

The rejection of claim 1 is incorporated, and Gryphon further teaches wherein the content advises existing process steps of the generic process plan (column 6, lines 10-12).

Per Claims 10 (Amended) & 11-14, 15 (Amended), 16-20:

These are apparatus versions of the claimed method discussed above (claims 1-9 and 21-22, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

Per Claim 23 (New):

This is a method version of the claimed apparatus discussed above, claim 18, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claim 24 (New):

The rejection of claim 1 is incorporated, and Gryphon further teaches wherein instructions respectively coded into non-generic process elements determine a sequence in which said non-generic process elements are merged into said generic process plan (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57).

Per Claim 25 (New):

The rejection of claim 1 is incorporated, and Gryphon further teaches wherein said instruction coded into each of said at least one non-generic process element introduces new process steps into said generic process plan (column 7, lines 14-21).

Per Claim 26 (New):

The rejection of claim 1 is incorporated, and Gryphon further teaches wherein said instruction coded into each of said at least one non-generic process element advises existing process steps in said generic process plan (column 7, lines 24-31).

Per Claims 27-29 (New):

These are apparatus versions of the claimed method discussed above (claims 24-26, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

Response to Arguments

13. Applicant's arguments filed on 05/02/2005 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) In order to establish a prima facie case of obviousness, all of the claim limitations must be taught or suggested by the prior art. The combination of Gryphon and Ernst fails to teach or suggest all of the claim limitations. For example, the combination fails to teach or suggest each non-generic process element containing an instruction determining how its content is to be

woven into the generic process plan at run-time as required by independent claims 1 and 10 and their respective dependents. This claim limitation is supported by, for example, page 3, lines 12-15, page 7, lines 12-13, and page 8, lines 24-30 of the originally-filed specification.

Gryphon teaches a modeling system ...

Gryphon thus essentially teaches a method of pictorially representing process steps. In contrast, Ernst describes how the dynamic behavior of the flow of business processes can be considered when optimizing the business process. However, the term “dynamic” here is used in the sense of “changing over the ...

Accordingly, even if Ernst and Gryphon were combined as proposed by the Office Action, the combination would not have taught or suggested all of the claim limitations. The hypothetical Ernst/Gryphon combination therefore does not provide a solution to the problem of how to generate and modify task sequences and content so that meta-information on the current context of a business process affecting its structure, can be woven into a generic business process at run-time. In contrast, the present invention provides a solution that effectively simplifies what was previously a complex programming task, by structuring the particular non-generic process elements in such a way that they contain the necessary instructions to merge their content into a business process in a correct manner. (See, e.g., page 8 lines 30-34 of the specification).

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §103 over Gryphon in view of Ernst be withdrawn. ...

New claims 23-29 have been added to provide additional protection for the invention. Each of these claims depends directly or indirectly from either independent claim 1 or 10 and are thus allowable for at least the reasons discussed above with respect to these independent claims.

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that the combination of Gryphon and Ernst fails to disclose the claimed limitations recited in claims 1-29. The combination of Gryphon and Ernst clearly shows each and every limitation in claims 1-29.

The combination of Gryphon and Ernst teaches wherein an instruction coded into each of the at least one non-generic process element determines how content is merged from the non-generic process element into the generic process plan (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57; "Action" is interpreted as a non-generic process element, where "Action" is associated with "Step". A generic process plan is defined as a sequence of Steps, where each step is searched for an action that is associated with the step, and then an action is defined and deployed as part of the step; thereby, generating a new process plan. The instructions are coded into the Action.).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., woven or meta-information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, see the rejection above in paragraph 12 for rejection to claims 1-29.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
July 28, 2005

A handwritten signature in black ink, appearing to read "Anthony Nguyen-Ba", written in a cursive style.

**ANTONY NGUYEN-BA
PRIMARY EXAMINER**